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10/657,456

09/08/2003

Michael Hattersley

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9809

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EXAMINER

SHRESTHA, BIJENDRA K

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

08/19/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/657,456

Applicant(s)

HATTERSLEY ET AL.

Examiner

BIJENDRA K. SHRESTHA

Art Unit

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Non-Final Office action is in response to the response filed on July 27, 2009.  
Claims 1-20 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/27/2009 has been entered.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-11, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. These claims are directed towards steps of "receiving.....", " depositing .....", "comparing..." and "generating....." without including a tie to a machine. Since the claims are directed

to a process without including a tie to a machine, these claims fall within the scope of human intelligence alone, and are non-statutory.

Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

*Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable by Hutchinson et al., U.S. Pub No. 2005/0102188 (reference A in attached PTO-892) in view of Herziger, U.S. Pub No. 2002/0082994 (reference B in attached PTO-892) further in view of Tedesco et al., U. S. Patent No. 6,282,523 (reference C in attached PTO-892).

3. As per claim 1, Hutchinson et al. teach a method of providing underwriting and/or servicing of an financial account, comprising the steps of:

receiving account application information including a bank account information (see Fig. 7; 8A-D; Fig. 15, step 270-274);

depositing at least one deposit amount to the bank account corresponding to the received bank account information (see Fig. 9C and 10C, Prepay; paragraph [0048] and [0085]; where buyer account must be prepaid which could be deposited by ACH or traditional bank check);

generating a financial account corresponding to the received account application information (see Fig. 8E-G; Fig. 15, step 265), where the financial account is electronically linked to the bank account (see paragraph [0011] and [0048]).

Hutchinson et al. do not teach receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount.

Herziger teaches receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount (Herziger, Fig. 8, paragraph [0127]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount of Hutchinson et al. because Herziger teaches that including above features would enable user with deposit verification module to effectively manage deposit verification reducing amount of training needed to accomplish deposit verification and reducing processing error (Herziger, paragraph [0129]).

Hutchinson et al. do not teach a balance amount of the bank account is periodically verified.

Tedesco et al. teach a balance amount of the bank account is periodically verified (Fig. 5, step 508; Fig. 3, Available Balance (314); column 5, lines 21-46; where balance available for financial account is verified on each transaction related to the financial account).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a balance amount of the bank account is periodically verified of Hutchinson et al. because Tedesco et al. teach that including above features would enable to bank to be involve in transaction which provides amount of funds

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available or unavailable for use for the financial account (Tedesco et al., column 3, lines 13-15; 33-38).

Examiner notes that the claim language “to confirm that the balance amount is equal to or greater than an outstanding balance amount of the financial account” pertains to intended use recitation which do not carry any patentable weight (see MPEP Form Paragraph 07-37-09).

4. As per claim 2, Hutchison et al. in view of Herziger teach claim 1 as described above. Hutchison further teach the method including

the step of receiving a periodic debit transaction amount (see paragraph [0048]; where financial (virtual) account uses bank electronic fund transfer using Automated Clearing House (ACH) standard; Examiner notes ACH allows periodic debit transaction amount).

5. As per claim 3, Hutchison et al. in view of Herziger teach claim 2 as described above. Hutchison further teach the method wherein

the periodic debit transaction amount is configured to be periodically debited from the bank account electronically to the financial account (see paragraph [0048] and claim 2).

6. As per claim 4, Hutchison et al. in view of Herziger teach claim 3 as described above. Hutchison further teach the method wherein

the periodic debit transaction is performed at 30 day interval (see paragraph [0048]; where ACH allows debit transaction for any specific period of interval).

7. As per claim 5, Hutchison et al. in view of Herziger teach claim 2 as described above. Hutchison further teach the method wherein

the periodic debit transaction amount includes one of a full balance of the financial account, a minimum payment amount of the financial account, and a minimum payment amount of the financial account plus a predetermined payment amount (see Fig. 10A-10C).

8. As per claim 6, Hutchison et al. in view of Herziger teach claim 1 as described above. Hutchison further teach the method including

the step of performing credit verification based on the received account application information (see Fig. 16, steps 285-289).

9. As per claim 7, Hutchison et al. in view of Herziger teach claim 6 as described above. Hutchison further teach the method wherein the step of performing credit verification includes the steps of:

transmitting the account application information to a credit bureau (see Fig. 16, Fig. 22); and

receiving a credit history information corresponding to said transmitted account application information (see Fig. 21).

10. As per claim 8, Hutchison et al. in view of Herziger teach claim 7 as described above. Hutchison further teach the method wherein

the credit history information includes a numeric representation of the account application information (see Fig. 16, steps 286 and 287).



11. As per claim 9, Hutchison et al. in view of Herziger teach claim 1 as described above. Hutchison further teach the method wherein

the financial account is a credit card account (see Fig. 7; 8E).

12. As per claim 10, Hutchison et al. in view of Herziger teach claim 1 as described above. Hutchison further teach the method including

the step of generating a financial account default notification when the balance amount of the linked bank account falls below a predetermined minimum level (see paragraph [0130]; where standard late payment processing, such as late notices, finance charges, etc are performed if buyer do not pay as agreed).

13. As per claim 11, Hutchison et al. in view of Herziger teach claim 10 as described above. Hutchison further teach the method including

the step of transmitting said financial account default notification (see paragraph [0130]; where default notification include charging interest, late notices or finance charges).

14. As per claim 12, Hutchison et al. teach a system for providing underwriting and/or servicing of an financial account, comprising:

a data network (see Fig. 2);

a user terminal operatively coupled to said data network configured to transmit and receive data therefrom (see Fig. 2, Buyer (50));

a server terminal operatively coupled to said data network (see Fig. 2; Seller Server (51)), said server terminal further configured to:

receive account application information including a bank account information from said user terminal (Fig. 2; Fig. 7, steps 100-104);

deposit at least one deposit amount to the bank account corresponding to the received bank account information (see Fig. 9C and 10C, Prepay; paragraph [0048] and [0085]; where buyer account must be prepaid which could be deposited by ACH or traditional bank check); and

generate a financial account corresponding to the received account application information (see Fig. 8E-G; Fig. 15, step 265), where the financial account is electronically linked to the bank account (see paragraph [0011] and [0048]).

Hutchinson et al. do not teach receive a deposit verification amount, compare the received deposit verification amount with the deposited at least one deposit amount.

Herziger teaches receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount (Herziger, Fig. 8, paragraph [0127]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount of Hutchinson et al. because Herziger teaches that including above features would enable user with deposit verification module to effectively manage deposit verification reducing amount of training needed to accomplish deposit verification and reducing processing error (Herziger, paragraph [0129]).

Hutchinson et al. do not teach a balance amount of the bank account is periodically verified.

Tedesco et al. teach a balance amount of the bank account is periodically verified (Fig. 5, step 508; Fig. 3, Available Balance (314); column 5, lines 21-46; where balance available for financial account is verified on each transaction related to the financial account).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a balance amount of the bank account is periodically verified of Hutchinson et al. because Tedesco et al. teach that including above features would enable to bank to be involve in transaction which provides amount of funds available or unavailable for use for the financial account (Tedesco et al., column 3, lines 13-15; 33-38).

Examiner notes that the claim language “ to confirm that the balance amount is equal to or greater than an outstanding balance amount of the financial account” pertains to intended use recitation which do not carry any patentable weight (see MPEP Form Paragraph 07-37-09).

15. As per claim 13, Hutchison et al. in view of Herziger teach claim 12 as described above. Hutchison further teach the system wherein

the server terminal is further configured to receive a periodic debit transaction amount from the user terminal (see paragraph [0048]; where financial (virtual) account

uses bank electronic fund transfer using ACH standard; Examiner notes ACH allows periodic debit transaction amount).

16. As per claim 14, Hutchison et al. in view of Herziger teach claim 13 as described above. Hutchison further teach the system wherein

the server terminal is configured to periodically debited said periodic debit transaction amount from the linked bank account electronically to the financial account (see paragraph [0080] and claim 13 above).

17. As per claim 15, Hutchison et al. in view of Herziger teach claim 14 as described above. Hutchison further teach the system wherein

the periodic debit transaction is performed at 30 day interval (see paragraph [0048]; where ACH allows debit transaction any specific period).

18. As per claim 16, Hutchison et al. in view of Herziger teach claim 13 as described above. Hutchison further teach the system wherein

the periodic debit transaction amount includes one of a full balance of the financial account, a minimum payment amount of the financial account, or a minimum payment amount of the financial account plus a predetermined payment amount (see Fig. 10A-10C).

19. As per claim 17, Hutchison et al. in view of Herziger teach claim 12 as described above. Hutchison further teach the system wherein the server terminal is further configured to:

transmitting the account application information to a credit bureau (see Fig. 16, Fig. 22); and

receiving a credit history information corresponding to said transmitted account application information (see Fig. 21).

20. As per claim 18, Hutchison et al. in view of Herziger teach claim 12 as described above. Hutchison further teach the system wherein

the financial account is a credit card account (see Fig. 7; 8E).

21. As per claim 19, Hutchison et al. in view of Herziger teach claim 12 as described above. Hutchison further teach the system wherein

the server terminal is configured to:

generate a financial account default notification when the balance amount of the linked bank account falls below a predetermined minimum level (see Fig. 2; paragraph [0130]; where financial institution (59) will generate default notification which include late notices, finance charges); and

transmit said account default notification to the user terminal (see Fig. 2; paragraph [0130]; where financial institution (59) issues late notices or levy finance charge to user through data network).

22. As per claim 20, Hutchison et al. teach a program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of providing underwriting and/or servicing of a financial account (see Fig. 2; paragraph [0055]), comprising the steps of:

receiving account application information including a bank account information (Fig. 2; Fig. 7, steps 100-104);

depositing at least one deposit amount to the bank account corresponding to the received bank account information (see Fig. 9C and 10C, Prepay; paragraph [0048] and [0085]; where buyer account must be prepaid which could be deposited by ACH or traditional bank check); and

generate a financial account corresponding to the received account application information (see Fig. 8E-G; Fig. 15, step 265), where the financial account is electronically linked to the bank account (see paragraph [0011] and [0048]).

Hutchinson et al. do not teach receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount.

Herziger teaches receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount (Herziger, Fig. 8, paragraph [0127]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow receiving a deposit verification amount, comparing the received deposit verification amount with the deposited at least one deposit amount of Hutchinson et al. because Herziger teaches that including above features would enable user with deposit verification module to effectively manage deposit verification reducing amount of training needed to accomplish deposit verification and reducing processing error (Herziger, paragraph [0129]).

Hutchinson et al. do not teach a balance amount of the bank account is periodically verified.

Tedesco et al. teach a balance amount of the bank account is periodically verified (Fig. 5, step 508; Fig. 3, Available Balance (314); column 5, lines 21-46; where balance available for financial account is verified on each transaction related to the financial account).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a balance amount of the bank account is periodically verified of Hutchinson et al. because Tedesco et al. teach that including above features would enable to bank to be involve in transaction which provides amount of funds available or unavailable for use for the financial account (Tedesco et al., column 3, lines 13-15; 33-38).

Examiner notes that the claim language “to confirm that the balance amount is equal to or greater than an outstanding balance amount of the financial account” pertains to intended use recitation which do not carry any patentable weight (see MPEP Form Paragraph 07-37-09).

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Bent et al. (U.S. Pub 2005/0108149) teach system and method for managing client accounts.

Fleischl et al. (U.S. Patent No. 6,038,552) teach method and apparatus to process combined credit and debit transactions.

Gross (U.S. Patent No. 6,721,716) teaches payment certification string and related electronic payment system and method.

Hogan (U.S. Patent No. 5,557,516) teaches system and method for conducting cashless transactions.

Grant et al. (U.S. Patent No. 4,694,397) teach banking/Brokerage computer interface system.

Kavoun (U.S. Pub No. 2004/0148251) teaches method and system for providing funds for on-line gaming.

Knapp (U.S. Pub No. 2004/0193537) teaches system and method for enhancing financial institution revenues through accelerated of debit processing.

Lindsay Brown (U.S. Pub No. 2006/0212393) teaches payment system and method.

McCoy et al. (U.S. Patent No. 6,932,268) teach dual mode credit card based payment technique.

Paschini et al. (U.S. Patent No. 7,131,578) teach system and method for electronic prepaid account replenishment.

Resnick et al. (U.S. Patent No. 6,185,545) teach electronic payment system utilizing intermediary account.

Wilkes (U.S. Pub No. 2004/0153399) teaches linking a merchant account with a financial card.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 7:00AM-4:30PM(Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
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